

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Justin Mortensen et al.

Docket No.: LSI.74US01 (03-0840)

Application No.: 10/621,085

Examiner: Giovanna B. Colan

Filed: July 15, 2003

Art Unit: 2162

For: DATA MANAGEMENT USING DISPERSED AND DISPARATE DATABASES

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Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Office Action dated May 14, 2007, made final, in the above-identified patent application, applicants hereby submit a Pre-Appeal Brief Request for Review in accordance with the Pre-Appeal Brief Conference Pilot Program.

Applicants make the following statement:

Claims 1-11 are currently pending in the above-identified patent application.

In the Response to Arguments beginning on page 14 of the Office Action dated May 14, 2007, the Examiner stated in part that: "In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features of claims 1 and 7 upon which applicant relies (i.e., 'the user is sent a requested file converted into transmittable form'; and that the claims as earlier amended require that: 'the content of said files remains unaltered') are not recited in such rejected claims."

A. Substance of Telephonic Interview dated 08 August 2007 between Giovanna Colan, Cam Y. Truong and Applicants' attorney Samuel M. Freund:

The Applicant Initiated Interview Request Form transmitted to the Examiner on 06 August 2007 by facsimile, requested that applicants wish to discuss the following two issues with the Examiner in order to advance the prosecution of the subject patent application:

1. In the Response to Arguments in the Office Action dated May 14, 2007, made final, the Examiner stated in part in Section 1 that the features of claims 1 and 7 upon which applicants rely; that is, "the user is sent a requested file converted into transmittable form"; and that the claims as earlier amended require that; "the content of said files remains unaltered") are not recited in such rejected claims. Applicants requested clarification from the Examiner as to why the amended language of claim 1 does not recite the features of claim 1 relied upon by applicants. Similar language is provided in independent claim 7, and applicants wish to discuss what language might clarify this claim as well; and

2. Concerning the combination of Cianfrocca with Ananian, the Examiner stated that such combination discloses all the limitations of claims 1 and 7; however, the combination does not expressly disclose: without content change of said requested file. Therefore, the Examiner stated that the Shapiro reference which discloses converting files to formats without content change of the requested file was presented. Applicants requested that the Examiner clarify why Shapiro should be and can be combined with Ananian, when the very teachings of Ananian clearly require that the user's plan set be modified to a standardized data set.

During the interview, applicants' attorney placed the first issue before the Examiners, pointing out that the limitation that "the content of said files remains unaltered" was indeed recited in rejected claims 1 and 7. However, as stated in the Examiner's Interview Summary, the Examiners asked applicants' attorney to specifically point out where in the Specification of the Disclosure this limitation was described. The Interview ended with disagreement that there was sufficient support for such limitation. The second issue was never discussed. Applicants wish to make note of the fact that this issue was newly raised by the Examiners during the interview, while claims 1 and 7 were amended to include this limitation in the Preliminary Amendment dated 11 October 2006.

B. Support For The Limitation 'without content change of said requested file':

Turning now to the to Examiners' assertion that the limitation 'without content change of said requested file' lacks support, applicants wish to direct the Examiner's attention to the following citations from the subject Specification, as originally filed. First, on page 4, lines 14-17, it is stated that: "Those users with the appropriate permission may request CAD data through company firewalls, have **that** data retrieved, translated if necessary, and delivered simply and effectively in a process that was heretofore cumbersome and typically involved two people at each end of the transaction." (Emphasis added by applicants.). The use of the word "that" in this context, clearly indicates that the retrieved data are the very same CAD data that were requested. Moreover, page 5, lines 6-7, state: "The system of embodiment 100 may allow users from different companies to **share** files and information in a simple and easy manner."; and on page 7, lines 29-30 it is stated that: "Figure 2 illustrates an embodiment 200 of the present invention showing the interactions of various components of a system for **sharing** files." (Emphasis added by applicants.). In accordance with definitions provided by Google Search, meanings for the word "share" include: (a) use jointly or in common; (b) partake: have, give, or receive a share of; 'We shared the cake'; and (c) A resource made available to others across a network. The essence of these definitions is that "share" means using or receiving the **same** thing.

Further, on page 8, lines 5-9, of the Specification, as originally filed, it is stated that: "The communications service 216 may send a message to the second server 206 requesting the file, whereupon the second server 206 may retrieve the file from database 218 and either transmit the requested 220 file **directly** to the workstation plug-in 202 or send the requested file 222 to the

communications service 216.” (Emphasis added by applicants.). Google Search defines “directly” as: (a) without deviation; and (b) without anyone or anything intervening. Therefore, the subject Specification teaches that files may be transmitted without change.

Thus, applicants believe that although the exact words “without content change of said requested file” do not appear as such in the subject Specification, as originally filed, the equivalent concepts and words are clearly present therein.

C. Identification of the recitation that ‘the user is sent a requested file converted into transmittable form’:

The last 3 recitations in claim 7 state: “... sending a request from said clearinghouse server to said second database for said requested file; converting said requested file to a first transmittable format without content change of said requested file; and transmitting said requested file from said second database in said first transmittable format.” Clearly, the requested file is transmitted to the clearinghouse server. In page 5, lines 8-10, of the subject Specification, as originally filed, states: “A clearinghouse server 110 may provide an index to each of the various databases and facilitate communication between the companies while allowing each company its freedom to operate independently.” Although the word “user” does not appear in subject claims 1 and 7 since it is an unnecessary part of the recitation of the method, transmitting the requested file to the clearinghouse server which is recited in claim 1 as being located outside of the firewalls, along with the identification of the clearinghouse with users in the Specification clearly supports applicants previous arguments. A similar argument may be made for claim 7.

D. The Combination of Cianfrocca and Ananian with Shapiro Is Improper:

On page 14 of the Office Action dated May 14, 2007, the Examiner stated in part that: “However, **the combination of Cianfrocca with Ananian does not expressly disclose: without content change of said requested file.** Therefore, the Examiner presented the third reference Shapiro which discloses converting files to formats without content change of said requested file.” (Emphasis added by applicants.).

Assuming only for the purposes of what follows that the Examiner has properly combined Cianfrocca with Ananian, applicants respectfully believe that the Examiner has improperly combined Shapiro, for the alleged teaching of converting files to formats without content change of said requested file, with Cianfrocca with Ananian.

The Examiner has asserted that Shapiro explicitly discloses translating without modifying the content (Fig. 5, and 6, “Source Artwork ENGLISH”, and “Target Translated Artwork FRENCH”, Page 4, 5, and 6, [0051]. [0067], and [0072], lines 1-20, 9-13, and 8-11,”... the Extractor adds an attribute whose value corresponds to the sequential identification number and which **does not cause a change to the appearance of the object in the Artwork file...**” (Emphasis added); and further”... when translating from one language to another, the size of print (point size) may need to decrease, or increase, **to preserve the same legibility of original text...**” (Emphasis added).

Applicants wish to point out that the portions of Shapiro underlined by the Examiner do not address the issue of whether the content of the files has been changed; that is, appearance and text legibility are merely two attributes of the graphic documents.

Applicants wish to direct the Examiner's attention to paragraph [0051], wherein it is stated that: "The object of the invention is to provide an integrated expert system for efficiently transforming location based objects, such as text or graphic objects, included in a digital source Artwork file, for example a geographical map file or a CAD design, and creating a transformed target Artwork file. ... The required transformations are then operated on the objects stored in the table, partly manually but also automatically creating a transformed second intermediate database, which is subsequently integrated with the source file to create a target file, which represents, for example a new map with translated text objects on new layers." Turning to paragraph [0072] of Shapiro, it is stated that: "... Representation Rules 135 (group 25) are used to automatically change the Type Aspects and intrinsic attributes of objects due to different language, **aesthetic constraints that require size change etc.** i.e. when translating from one language to another, the size of print (point size) may need to decrease or increase, to preserve the same legibility of the original text. Such point size changes may require further changes such as leading, inter-letter space etc." (Emphasis added by applicants.).

Applicants wish to point out that Shapiro does actually change the databases. First, in FIG. 5 and FIG. 6, the language is changed from English to French. Although someone fluent in both English and French might not be inconvenienced by such change, an individual who had no understanding of French would not understand parts of FIG 6. Therefore, applicant fails to understand the Examiner's position that the content of the database has not been changed. To a user, the map has gone from understandable to incomprehensible. Since French has a few words in common with those in English, for emphasis consider the situation where the language was Chinese or Japanese, as examples.

Aside from the obvious changes in FIG. 5 and FIG. 6 of the actual languages associated with the map of Italy, paragraph [0072] teaches that the size of various items may be changed automatically in accordance with the teachings of Shapiro. Difficulties would be generated in a CAD program for an aircraft, as an example, since the parts would not fit together. Thus, applicants believe that the Examiner has improperly combined Shapiro with Ananian and Cianfrocca since Shapiro does not disclose the limitation "without modification of content," as suggested by the Examiner. Moreover, since Shapiro clearly teaches modification of database content, Shapiro teaches away from the present claimed invention.

Article 2141.02 Differences Between Prior Art And Claimed Invention, Section VI. Prior Art Must Be Considered In Its Entirety, Including Disclosures That Teach Away From The Claims, of the Manual Of Patenting Examining Procedure states: "A prior art reference must be considered in its entirety, i.e., as a whole including portions that would lead away from the claimed invention.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Applicants respectfully believe that the Examiner has not fully considered the teachings of Shapiro.

Article 2145, Consideration Of Applicant's Rebuttal Arguments, Section X.D.1. of the Manual Of Patent Examining Procedure states: "A prior art reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness; ... *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Since applicants respectfully believe that Shapiro teaches away from the present claimed invention, applicants believe that the Examiner has improperly combined Shapiro with Cianfrocca and Ananian.

E. Motivation For The Combination of Cianfrocca And Ananian with Shapiro Is Lacking:

The Examiner has stated that Shapiro discloses a suggestion for combining the references (Page 4, [0051], lines 1-9, Shapiro). As stated in paragraph [0051] of Shapiro, "The required transformations are then operated on the objects and stored in the table, partly manually but also automatically creating a transformed second intermediate database, which is subsequently integrated with the source file to create a target file, which represents, for example a **new** map with translated text objects on **new** layers." (Emphasis added by applicants.). Since, as stated hereinabove, applicants believe that Shapiro does indeed change the databases, applicants believe that there would be no motivation for combining Shapiro with Ananian and Cianfrocca. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

Therefore, applicants believe that independent claims 1 and 7 are patentable over Ananian in view of Cianfrocca and further in view of Shapiro.

In view of the discussion presented hereinabove, applicants believe that subject claims 1-11 are in condition for allowance, and such action by the Examiner at an early date is earnestly solicited.

Dated this 14th day of September, 2007.

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